

**This Opinion is Not a
Precedent of the TTAB**

Mailed: October 29, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Santini Fine Wines, Inc.
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Serial No. 85592838
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Luke Brean of BreanLaw, LLC,
for Santini Fine Wines, Inc.

Sung In, Trademark Examining Attorney, Law Office 103,
Michael Hamilton, Managing Attorney.

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Before Zervas, Bergsman and Adlin,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Santini Fine Wines, Inc. (“Applicant”) seeks registration on the Principal Register of the mark LEONESSA (in standard characters) for

Wine in International Class 33.¹

The application includes the following translation statement: “The English translation of ‘Leonessa’ in the mark is ‘lioness.’”

¹ Application Serial No. 85592838 was filed on April 9 2014, based upon applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that it so resembles the previously registered mark LEONESS CELLARS, in the stylized form shown below, for "bottles of wine, namely, wine sold in bottles," in Class 33, as to be likely to cause confusion:²



Registrant disclaimed the exclusive right to use the word "Cellars."

After the Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated

² Registration No. 4437796, issued November 26, 2013.

by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

A. The similarity or dissimilarity and nature of the goods, established, likely-to-continue channels of trade and classes of consumers.

The goods at issue – wine and “bottles of wine, namely, wine sold in bottles” – are identical. Because the goods described in the application and the cited registration are identical, we must presume that the channels of trade and classes of purchasers are also the same. *See In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

B. The similarity or dissimilarity of the marks in their entirety in terms of appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In a particular case, “finding of similarity as to any one factor (sight, sound or meaning) alone ‘may be sufficient to support a holding that the marks are confusingly similar.’” *In re White Swan Ltd.*, 8

USPQ2d 1534, 1535 (TTAB 1988) (citations omitted). *See also In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1987). In comparing the marks, we are mindful that where, as here, the goods are identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

Further, “[t]he proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721 (citation omitted). *See also San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d mem.*, 972 F.2d 1353 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Since the goods at issue are wine, the average customer is an ordinary consumer who purchases and drinks wine.

The dominant element of the LEONESS CELLARS mark is the word “Leoneess.” The word “Cellars” is defined, *inter alia*, as “a stock of wines.” “Cellar,” *Merriam-Webster.com* (2014).³ Accordingly, when used in connection with wine, the word “Cellars” is merely descriptive and has been disclaimed.⁴ It is well-settled that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), *quoting*, *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1983) (“Regarding descriptive terms, this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion”); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).

³ The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

⁴ Because an applicant may voluntarily disclaim a component of a mark, Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a), the mere fact that a word has been disclaimed in a cited registration does not *ipso facto* mean that the disclaimed term is descriptive. Accordingly, we may not assume that a disclaimed word in a cited registration is merely descriptive.

Further reinforcing the dominance of the word “Leonesse” in the cited registration is the size of that word in comparison to the word “Cellars.” The “Leonesse” is that portion of registrant’s mark that catches the viewer’s eye.

Finally, the location of the word LEONESS as the first part of the mark LEONESS CELLARS supports the importance of the word LEONESS in the registrant’s mark. *See Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”). *See also Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word).

In identifying the word LEONESS as the dominant element of the cited registration, we are not dissecting the mark. The similarity or dissimilarity of the marks has been determined based on the marks in their entireties; that is, our decision is based on the entire marks, not just part of the marks. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Franklin Mint Corp. V. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be

dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion”). On the other hand, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re National Data Corp.*, 224 USPQ at 751. As we pointed out above, we focus on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012).

The words LEONESSA and LEONESS are similar in appearance and sound. The only difference between the words LEONESSA and LEONESS is the letter “A” at the end of the word LEONESSA. Slight differences in marks do not normally create dissimilar marks. *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 485 (TTAB 1985) (“Moreover, although there are certain differences between the [marks’ CAYNA and CANA] appearance, namely, the inclusion of the letter ‘Y’ and the design feature in applicant’s mark, there are also obvious similarities between them. Considering the similarities between the marks in sound and appearance, and taking into account the normal fallibility of human memory over a period of time (a factor that becomes important if a purchaser encounters one of these products and some weeks, months, or even years later comes across the other), we believe that the marks create substantially similar commercial impressions”). *See also United States Mineral Products Co. v. GAF Corp.*, 197 USPQ 301, 306 (TTAB 1977) (“‘AFCO’ and ‘CAFACO,’ which differ only as to the letter ‘C’ in USM’s mark,

are substantially similar in appearance and sound”); *In re Bear Brand Hosiery Co.*, 194 USPQ 444, 445 (TTAB 1977) (“The mark of the applicant, ‘KIKS’ and the cited mark ‘KIKI’ differ only in the terminal letter of each mark. While differing in sound, the marks are similar in appearance and have a somewhat similar connotation”).

Applicant’s mark is presented in standard character form. Marks presented in standard characters are not limited to any particular depiction. The rights associated with a mark in standard characters reside in the wording and not in any particular display. *In re Viterra Inc.*, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983); *In re RSI Systems, LLC*, 88 USPQ2d 1445, 1448 (TTAB 2008); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988).⁵ In other words, Applicant’s mark could be displayed in a script form similar to the display of the registered mark.

Applicant’s mark LEONESSA means lioness and engenders that commercial impression. On the other hand, the word “Leonesse” in registrant’s mark appears to be an arbitrary term without any meaning when used in connection with wine and, therefore, registrant’s mark LEONESS CELLARS and design is an inherently distinctive mark entitled to protection against Applicant’s similar mark intended to be used for identical goods.

⁵ Prior to 2003, “standard character” marks were known as “typed” marks, but the nomenclature was changed to conform to the Madrid Protocol. Thus, the change to “standard character” from “typed” marks does not change the interpretation of the scope of such marks.

In view of the foregoing, we find that the similarities between marks LEONESS CELLARS and LEONESSA outweigh the differences and, therefore, we find that the marks are similar.

C. Balancing the factors.

Because the marks are similar and the goods are in part identical and we must presume that the goods move in the same channels of trade and are sold to the same classes of consumers, we find that Applicant's mark LEONESSA for wine is likely to cause confusion with the mark LEONESS CELLARS in stylized form for "bottles of wine, namely, wine sold in bottles."

Decision: The refusal to register Applicant's mark LEONESSA is affirmed.